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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/090,067 06/03/98 REDMOND

J NIS0007 *WC*

POLAROID CORPORATION
PATENT DEPARTMENT
748 MEMORIAL DRIVE
CAMBRIDGE MA 02139

GM12/0620

EXAMINER

CARTER, M

ART UNIT

PAPER NUMBER

3722 *H*

DATE MAILED:

06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/090,067

Applicant(s)
Redmond et al.

Examiner
Monica Carter

Group Art Unit
3722



☒ Responsive to communication(s) filed on Jun 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 3-6, 8-11, 13-16, 18-21, and 23-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-6, 8-11, 13-16, 18-21, and 23-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3722

DETAILED ACTION

Continued Prosecution Application

1. The request filed on June 2, 2000, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/090,067 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. Claims 1, 3-6, and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 10-12, it is not clear what applicant means by the recitation --and in a second color--. Is the second printed matter printed in a second color? As claimed, it appears that both the first and second printed matter are printed in a second color.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3722

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, 8-11, 13-16, 18-21, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Craven et al. (5,157,424) in view of Merry et al. (5,178, 418).

Craven et al. discloses a method and apparatus for manufacturing tamper-resistant identification cards comprising first printed matter (16) at a first location at a first scale, said first printed matter (16) being able to be viewed by a person without magnification, second printed matter (20) representing said first printed matter (16) rendered at a second location at a second scale in a single color, said second scale being significantly smaller than said first scale, said second location containing a graphical element (18), said first (16) and second (20) printed matter conveying identifying information, said first (16) and second (20) printed matter is specific to the identified person.

Craven et al. discloses the claimed invention except for the following: a second color to minimize contrast between said second color and said second location. Matters related to the choice of ornamentation producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability. In re Seid 73 USPQ 431.

Craven et al. discloses the claimed invention except for the following: said second printed matter consisting of relatively dark or light toned text printed on a background color which is either lighter or darker toned, respectively, said ⁹first and second printed matter comprising at least two digits of the year of a birth of a person, said second printed matter

Art Unit: 3722

being a graphical reproduction of said first printed matter, and a plurality of identification documents.

In regards to the contrasting colors of the second printed matter and the background, Craven et al. discloses printed matter having a color contrasting with the background of the document.

In regards to the first and second printed matter comprising at least two digits of the year of a birth of a person. Craven et al. discloses indicia relating to the personal identification, such as birth date, social security number, license number, of an individual. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the at least two digits of the year of a birth of a person in the second printed matter to increase the security of the document.

In regards to said second printed matter being a graphical reproduction of said first printed matter, Craven et al. discloses a second printed matter (20) superimposed over a photograph (18) relating to the first printed matter.

In regards to the plurality of identification documents, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of identification documents, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Art Unit: 3722

Craven et al. discloses the claimed invention except for the following: the second printed matter cannot be clearly viewed by a person without magnification. Merry et al. discloses a security device comprising printed matter (characters) that are viewed by magnification means. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the identification card of Craven et al., as taught by Merry et al. (5,178,418), to provide means of easily viewing printed matter on the card.

Craven et al. disclose the claimed invention except for the following: first and second printed matter comprising alphanumeric characters. Merry et al. disclose a security device comprising alphanumeric characters (col. 1, lines 49-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the identification card of Craven et al., as taught by Merry et al., to provide an alternate design of printed matter to secure the card.

Response to Arguments

5. Applicant's arguments filed June 2, 2000, have been fully considered but they are not persuasive. Examiner maintains rejections.

Applicant argues that neither Craven et al. nor Merry et al. do not disclose a document with second printed matter printed at a second location with a graphical element in second color to minimize contrast and hide the second printed matter. Craven et al. does disclose

Art Unit: 3722

second printed matter (20) printed at a second location with a graphical element (18) as seen in figure 1).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the graphical element hiding the second printed matter) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Contact Information


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, AL Wellington can be reached on (703) 308-2159. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148. In order to reduce pendency and avoid potential delays, Group 3722 is encouraging FAXing of responses to Office Actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not

Art Unit: 3722

requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into group 3722 will be promptly forwarded to the examiner.

mc
mc

June 15, 2000


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700